

REMARKS

The following remarks are believed responsive to the points raised by the Office Action dated December 12, 2002. In view of the following remarks, reconsideration is respectfully requested.

Claims 1 and 14-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,344,923 to Pall et al. (hereinafter referred to as "Pall '923") in view of U.S. Patent No. 5,543,047 to Stoyell et al. (hereinafter referred to as "Stoyell") and U.S. Patent No. 4,228,012 to Pall (hereinafter referred to as "Pall '012") and U.S. Patent No. 4,517,085 to Driscoll et al. (hereinafter referred to as "Driscoll"). This rejection is respectfully traversed.

Pall '923, the primary reference, is directed to filter units having a reserve filter element in series with a primary filter element, the reserve filter not coming into use until the primary filter element in the line of normal fluid flow becomes plugged (col. 1, lines 24-28). As set forth in Pall '923, a filter assembly consisting of a cylindrical housing and two annular filters in end-to-end relation within the housing are separated by an annular adapter (Abstract). The annular adapter of Pall '923 maintains the second filter element in reserve and entirely separated from the primary element, in such a manner that normal flow by-passes the second reserve element. When the primary filter element of Pall '923 becomes clogged, the pressure responsive means included on the annular adapter opens to open a direct line from the inlet passage to the reserve filter element, bypassing the primary filter element (see e.g., Abstract and col. 2, lines 3-13). Clearly, the filter assembly of Pall '923 is intended to direct fluid through a single filter element and to provide an adjacent unused filter element as a replacement.

In contrast to the filter assembly disclosed in Pall '923, the separation element defined in claim 1 includes two or more pack sections and adjacent open joiner caps secured to coaxially connect the pack sections and open joiner caps into one "primary" separation arrangement being at least about 40 inches in length and having an interior diameter of at least about 2 inches. Thus, Pall '923 is completely different from the presently claimed invention and indeed teaches directly away from securing adjacent open joiner caps to coaxially connect the pack sections and open joiner caps into a hollow separation arrangement (e.g., an arrangement that allows fluid to flow through the connected pack sections).

Furthermore, even in combination, the references do not disclose or suggest a hollow separation arrangement being at least 40 inches in length and having an interior diameter of at least about 2 inches. According to the Office Action, it is considered obvious to one of ordinary skill in the art at the time of the invention to modify the length of the separation element of Pall '923 as modified by Stoyell, in such a way that the element has a length of at

least about 40 inches and has an interior diameter of at least about 2 inches, as a matter of choice by the user, as well as to increase the filtration capability of each separation element. However, the Office Action has failed to identify any motivation in the prior art for making such a modification. None of the cited references suggest the desirability of the combination of a length of at least about 40 inches and an interior diameter of at least about 2 inches. According to MPEP §2143.01, the mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the modification. Accordingly, prima facie obviousness has not been established.

Additionally, the Office Action cites *Gardner v. TEC Systems, Inc*, 725 F.2d 1338, 220 USPQ 777 (Fed Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984), to assert that a prima facie case of obviousness exists when the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and the device having the claimed relative dimensions would not perform differently than the prior art device. The Office Action asserts the separation element of Pall '923 as modified by Stoyell and Pall '012 would not perform differently than the claimed invention. Applicants respectfully disagree. The device of claim 1 does perform differently from the prior art. For example, the combination of a length of at least 40 inches and an interior diameter of at least 2 inches effectively allows much higher throughputs than prior art devices not having the claimed combination of length and interior diameter dimensions. As can be seen from the data in Table 1 of the specification, separation elements including the claimed dimensions operate effectively at significantly higher flow rates and throughputs than devices having shorter lengths and/or smaller interior diameters.

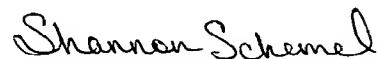
In summary, there is nothing in the cited references that would lead one of ordinary skill in the art to the present invention as defined in the pending claims.

In view of the remarks recited herein, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

In re Appln. of Connors et al.
Application No. 09/091,508

Should there remain any issues outstanding, the Examiner is invited to call the undersigned attorney at her Washington, D.C. office.

Respectfully submitted,



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